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10/820,832	04/07/2004	Sean Christopher Endler	86604/7114	8497
37123 7590 09/29/2008 FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE SUITE 1600 CHICAGO, IL 60603				
EXAMINER BERMAN, BRIAN J				
ART UNIT 3688		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/820,832

**Applicant(s)**

ENDLER ET AL.

**Examiner**

BRIAN BERMAN

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to the amendment filed on May 12, 2008.

Claims 1-29 are still currently pending and have been considered below.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by Examiner.

### **Claim Objections**

2. In claim 13, "includes a location field a type of product" should apparently be -- includes a location field, a type of product--. A comma (,) is missing. Please insert the comma.

In claim 27, "time and **data** validity" should apparently be "time and **date** validity".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, the element "means for detecting, means for searching, means for receiving, and means for selecting" is a means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

Applicant is required to:

a) Amend the claim so that the claim limitation will no longer be a means plus function limitation under 35 U.S.C. 112, sixth paragraph; or

b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132 (a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132 (a)); or

b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification,

perform the claimed function. For more information, see 37 CFR 1.75 (d) and MPEP 2181 and 608.01 (o).

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16 and 23-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**As per Claim 16:** Claim 16 recites “means for detecting, means for searching, means for receiving, and means for selecting”. However, according to the Specification, the “means for” could be software. Therefore, as the system claim is broad enough to be read on software, it is non-statutory under 35 U.S.C. § 101 (MPEP 2106.01). Specifically, in independent claim 16, the preamble of the claim recites a system, indicating structure or hardware, whereas the body of the claim recites data or software per se, which is not statutory. Further, the “means for” as defined in the specification, represent software, not hardware. The preamble talks about a system, while the body recites software per se.

As per claims 23-28: Claim 23 recites “device detection module, storage module, and promotion location selection module”. Specifically, in independent claim 23, the preamble of the claim recites a system, indicating structure, means plus function or hardware, whereas the body of the claim recites data or software per se, which is not

statutory. Further, a device detection module, storage module, and promotion location selection module, as defined in the specification, represent software, not means or Hardware. The dependent claims 24-28 do not overcome this problem. This renders the claims confusing under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(e) the invention was described in - (1) an application for patent, published under **section 122(b)**, by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in **section 351(a)** shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under **Article 21(2)** of such treaty in the English language

5. Claims 1-20 and 23-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Jokinen et al. (hereinafter Jokinen), US Patent 7,343,317 B2.

**Concerning Claim 1**, Jokinen discloses the invention as claimed, including:

A method comprising:

detecting a device capable of receiving and transmitting an electronic message;

(Summary of Invention, abstract, col 14, lines 6-25; col 5, lines 18-30)

searching for a plurality of promotions stored in a storage module; (col 6, lines 50-54)

receiving a signal from the detected device and detecting a device profile corresponding to the device (col 5, lines 18-22) wherein the device profile contains a preference for a product or a service (col 5, lines 53-61) and a geographical boundary; and (col 5, lines 33-38)

selecting a particular promotion from the plurality of promotions based on the preference for the product or the service (col 5, lines 53-61, col 5, lines 41-55, col 6, lines 3-6, col 6, lines 51-55) and the geographical boundary associated with the device profile. (col 5, lines 33-38)

**As to Claim 2**, Jokinen further discloses

The method according to claim 1 further comprising detecting the location of the device using the global positioning system. (col 5, lines 22-38; abstract)

**As to Claim 3**, Jokinen further discloses

The method according to claim 2 wherein the geographical boundary is relative to the current location of the device. (col 5, lines 22-38)

**As to Claim 4**, Jokinen further discloses

The method according to claim 1 wherein in the step of selecting a particular promotion, the particular promotion is selected based on the valid hours of availability. (col 7, lines

40-48, col 8, lines 16-25)

**As to Claim 5**, Jokinen further discloses

The method according to claim 1 wherein in the step of searching for a plurality of promotions, each of the plurality of promotions includes an electronic coupon. (col 6, lines 3-6)

**As to Claim 6**, Jokinen further discloses

The method according to claim 1 wherein the device profile is received in a signal sent from the device. (abstract)

**As to Claim 7**, Jokinen further discloses

The method according to claim 1 further comprising detecting a promotion profile for each of the plurality of promotions. (col 8, lines 16-20)

**As to Claim 8**, Jokinen further discloses

The method according to claim 7 wherein the promotion profile for each of the plurality



of promotions includes location information. (col 5, lines 33-38, col 7, lines 40-48)

**As to Claim 9**, Jokinen further discloses

The method according to claim 7 wherein the promotion profile for each of the plurality of promotions includes a description of offerings. (col 6, line 19)

**As to Claim 10**, Jokinen further discloses

The method according to claim 7 wherein the promotion profile includes days and time of validity for each of the plurality of promotions. (col 8, lines 16-31, col 11, lines 1-26)

**As to Claim 11**, Jokinen further discloses

The method according to claim 7 wherein selecting the particular promotion is based on the promotion profile for each of the plurality of promotions. (col 8, lines 47-51)

**As to Claim 12**, Jokinen further discloses

The method according to claim 1 further comprising displaying the particular promotion on the device. (abstract)

**As to Claim 13**, Jokinen further discloses

The method according to claim 1 wherein the particular promotion displayed on the device includes a location field (col 13, lines 30-32, col 13, lines 42-54) a type of product or service field, (col 13, lines 27-28) an hours of availability field (Fig. 5, place order before 8 P.M., expiration time, col 12, lines 46-52, col 7, lines 40-49) and contact information field. (col 13, lines 25-28, Fig. 10, B-Burger, the name of the store on the electronic coupon is read as contact information)

**Concerning Claim 14**, Jokinen further discloses

The method according to claim 1 wherein the device is associated with a particular user (col 9, lines 45-49) and has attributes that include a device attribute, (col 4, lines 48-60, col 7, lines 4-30) a user identity attribute, (col 5, lines 53-61) a geographic boundary attribute (col 5, lines 33-38) and a product or service attribute. (col 5, lines 53-61)

**Concerning Claim 15**, Jokinen further discloses

The method according to claim 1 wherein the device is associated with multiple users (col 9, lines 20-41) and has attributes that include a device attribute, (col 4, lines 48-60, col 7, lines 4-30) a plurality of user identity attributes, (col 5, lines 53-61) a geographic boundary attribute (col 5, lines 33-38) and a product or service attribute. (col 5, lines 53-61)

**As to Claim 16**, Jokinen discloses the system for implementing the method of claim 1.  
(see discussion of claim 1)

**As to Claim 17**, Jokinen discloses the invention as claimed, including:

A method comprising:

detecting a plurality of devices capable of receiving and transmitting an electronic message; (Summary of Invention, abstract, claims 5-8, col 14, lines 6-25; col 5, lines 18-30)

identifying a location for a meeting among the plurality of devices; (col 5, lines 33-38)

searching for a plurality of promotions (e-coupons) stored in a storage module; and (col 5, lines 33-38, col 6, lines 50-54)

selecting a particular promotion (the offer) from the plurality of promotions (e-coupons) based on the location of the meeting. (col 5, lines 33-38)

Here, Jokinen discloses a method for detecting the presence of a plurality of mobile devices within a vicinity or geographic location (meeting location of the users), querying or searching a database storing a plurality of targeted promotions (advertisements and coupons) and selecting a particular promotion, based at least on the geographic location (meeting location) of the mobile devices, from the plurality of stored promotions and providing the promotion or a coupon to the users of the mobile devices, the value of which is computed based on the number of mobile devices currently present in the vicinity. (Jokinen, col 5, lines 33-38; col 7, lines 40-49, col 14, lines 32-37)

**As to Claim 18**, Jokinen further discloses

The method according to claim 17 wherein selecting the particular promotion is based on a time of the meeting. (col 7, lines 42-49; col 8, line 29)

**As to Claim 19**, Jokinen further discloses

The method according to claim 17 wherein selecting the particular promotion further comprises matching the location with the particular promotion such that the particular promotion is utilized at the location. (col 7, lines 44-49, e-coupon is used at store, col 1, lines 64-67, col 13, 25-30)

**As to Claim 22**, Jokinen further discloses

The method according to claim 17 further comprising detecting a current location for each of the plurality of devices. (col 5, lines 22-30; col 8, line 48)

**As to Claim 23**, Jokinen discloses the invention as claimed, including:

A system, comprising:

a device detection module to detect a device associated with a user; (col 14, lines 6-25; col 5, lines 18-30)

a storage module to store a device record containing user information associated with the user and a promotion record containing promotion information associated with a promotion; and (col 5, lines 39-43; col 6, lines 18-20)

a promotion location selection module to select a particular promotion based on the user information that includes a preference for a product or a service (col 5, lines 53-61, col 5, lines 41-55, col 6, lines 3-6, col 6, lines 51-55) and a geographical boundary associated with the device, (col 5, lines 33-38) and the promotion information. (col 8, lines 48-51, claim 11)

**As to Claim 24**, Jokinen further discloses

The system according to claim 23 wherein the geographical boundary is relative to the current location of the device. (col 5, lines 22-38)

**As to Claim 25**, Jokinen further discloses

The system according to claim 23 wherein the current location of the device is determined using a global positioning system. (col 5, lines 22-38; abstract)

**As to Claim 26**, Jokinen further discloses

The system according to claim 23 wherein the particular promotion selected by the promotion selection module includes an electronic coupon. (abstract, col 6, lines 3-6)

**As to Claim 27**, Jokinen further discloses

The system according to claim 23 wherein the promotion information includes a time and data validity. (col 8, lines 16-31, col 11, lines 1-26)

**As to Claim 28**, Jokinen further discloses

The system according to claim 23 wherein the promotion information includes location information. (col 5, lines 33-38, col 7, lines 40-48)

**Claim 29:** Claim 29 is the computer-readable medium to perform the method claim 17, and is rejected in a like manner.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 20 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jokinen et al. (hereinafter Jokinen), US Patent 7,343,317 B2 in view of Official Notice.

**Concerning Claim 20**, Jokinen discloses the invention substantially as claimed, according to claim 17.

Jokinen does not teach the step wherein selecting the particular promotion further comprises matching the location with the particular promotion such that the particular promotion is utilized at a competing location.

However, Official Notice is taken that the use of sending advertisements to people to use at a competitor has been known as a basis for the competitor to easily target customers who are likely to purchase competitor's products or services. At a grocery store, when a person buys one brand of beverage (Coke), the person will get coupons when checking out (comprising coupons from not only Coke, but also coupons from competitors: such as Pepsi and Dr. Pepper). Many people shop around at multiple stores before purchasing an item. When people want to buy furniture (such as office chairs, desks, beds), many people shop around at least three different stores before making a purchase. When a person is at store one, it would be great to receive coupons from competitors' stores, since the person was already going to look at multiple stores before deciding which store to make his purchases.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Jokinen* with the commonly recognized practice of matching the location with a promotion that would be utilized at a competing location (competitor's store) as a cheap and efficient way for a competitor to advertise to the competitors' target audience, that is people who have already shown an interest in buying that kind of product (such as Coke or soda). Also, there are sponsored links when people do a Google search. These companies (sponsored links) benefit by promoting their product, which may be a competitor to the store people were looking for when they searched on the internet. The rationale would have been for a competitor to cost-effectively market to potential future customers who have already shown an interest in buying that general kind of product, so the people are more likely to buy similar items at a competitors' store (competing location).

**Concerning Claim 21**, *Jokinen* discloses the invention substantially as claimed, according to claim 17.

*Jokinen* does not teach the step wherein selecting the particular promotion further comprises matching the location with the particular promotion such that the particular promotion is utilized at another location unrelated to the location.

However, Official Notice is taken that the use of sending advertisements to people to use at a different location unrelated to the current location has been known as a basis for a company to advertise to new people, who may or may not be interested in companies' products. At a grocery store, when a person buys one brand of beverage



(Coke), the person will get coupons when checking out (comprising coupons from not only Coke, but also coupons from products that a user has never purchased such as chips and salsa). A new company might only have one store in Washington, DC. This company will need to advertise in other states (other locations) if the company wants to sell products nationally. The company might want to advertise to all types of people, in order to sell products to anyone to grow and expand the company. For example, a company might give out advertisements (coupons) for running shoes to anyone in Los Angeles, even though the company (store) is only located in Washington, DC. Shoes are an item that everyone uses, so the fact that the promotion is at another location than the location of the store is not significant. If people like the shoes, they could simply buy the shoes over the internet. The company's location is unrelated to the location of the promotion or advertisements.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *Jokinen* with the commonly recognized practice of matching the location with a promotion that is utilized at another location unrelated to the location of the promotion as a way to try and attract new customers (who may have never even considered buying this type of product). The potential customer may have never even heard of the product. The potential customer may be more likely to buy the product, since potential customer may not know of competitors who sell similar products. If coupons are used (promotion), people are even more likely to try out this product for the first time. Also, there are sponsored links on many websites. For example, the dating site [www.True.com](http://www.True.com) advertises on many different

unrelated websites (trying to target as many people as possible, since anyone located anywhere might be interested in online dating). Since so many people might be interested in dating, the company sends advertisements to people, even without information that a person is interested in getting help to find a date. A company may choose to promote to other unrelated locations, different than where the company resides. A new, emerging company might not yet know who his target audience comprises. A company might want to simply build popularity of its name by getting the companies' name out to as many people as possible, as opposed to specific target groups. A company promotes their generic product (without a need of checking to see if people are first looking for help in online dating or purchasing shoes) since so many different people are looking for help to spend money on these generic items, a company may choose the most cost-effective marketing technique is simply to send advertisements at a promotion location, which is totally unrelated to the location of the store. The rationale would have been for a store to target a whole new set of potential customers, including people who may have never even heard of the products being advertised or promoted, or to promote a generic product (such as online dating or shoes) that anyone might be interested in spending money on these generic items.

### **Response to Arguments**

7. Applicant's arguments filed on May 12, 2008 have been fully considered but they are not persuasive. Applicant denies the rejection without distinctly and specifically pointing out the supposed errors in the examiner's action. It is not sufficient to point out the supposed errors in the reference. This fails to comply with 37 CFR 1.111(b).

Claims 1-16 and 23-28: Jokinen discloses a user profile database, which includes user-defined information and a user's preferred types of goods and services. (col 5, lines 53-61) A user also decides what kind of advertisements he wants to receive. A person may choose to receive jewelry advertisements, but he may not want to receive electronic equipment advertisements. (col 8, lines 2-15)

Claims 17-22 and 29: Jokinen describes limiting the distribution of electronic coupons by location. Electronic coupons are transmitted in a limited transmission area or near a store (**location for a meeting**) so that only people within the range of the communication link receive the offer. The transmission area or near a store is a location. A meeting can take place at this location. Therefore, Jokinen shows "identifying a location for a meeting".

Claims 20 and 21: Official notice of this common knowledge or well-known in the art statement was taken in the last Office action (Paper No. 10/820832, mailed 3/20/2008). This statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice. (MPEP 2144.03.C.) The traverse was not seasonal, meaning that applicant did not traverse in reply to the taking of official notice.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 6,332,127 to Bandera et al. teaches system and methods for providing time and location specific advertising via the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Berman whose telephone number is (571) 270-3603. The examiner can normally be reached on Monday through Thursday 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Berman/  
Examiner, Art Unit 3688

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688

9/20/2008